LIBRARY
SUPREME COURT, U. S.
FILED
APR 29 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1364

RHONE-POULENC, S.A., DENISE MANCY, LEON NINET & JEAN PREUD'HOMME, *Petitioners,*

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

ELLSWORTH H. MOSHER
CHARLES A. WENDEL
STEVENS, DAVIS, MILLER & MOSHER
1911 Jefferson Davis Highway
Arlington, Virginia 22202
(703) 920-8900

Attorneys for Petitioners

April, 1975

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

INDEX

	Page
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutory Provisions Involved	3
Statement of the Case	4
Reasons for Granting the Writ	9
(1) The Court of Appeals, having decided the only question presented by the record for its decision, should at that point have "stopped" and not thereafter have proceeded to decide a question not presented by the record	9
(2) The Court of Appeals should not in any event have decided or have purported to decide an issue on appeal that was not presented to and decided by the lower court	10
(3) The Court of Appeals, as an Article III court, should have refrained from encroaching upon the jurisdiction of the administrative agency specifically empowered by Congress to decide in the first instance questions arising during the *ex parte* prosecution of patent applications, including questions of alleged new matter	11
(4) The decision of the Court of Appeals purporting to give leave to the Commissioner to "allow" a restrictive amendment to petitioners' specification describing an admittedly patentable invention presents a direct conflict with a recent decision of the Court of Customs and Patent Appeals—a conflict that can only be resolved by this Court on certiorari	15
(5) On the merits, the Court of Appeals decided the question of alleged new matter in an erroneous manner highly prejudicial to the petitioners	16
Conclusion	19

Page

APPENDIX

RELEVANT EXCERPTS FROM THE CONSTITUTION OF THE UNITED STATES AND THE STATUTES 1a

From Article I, Section 8 of the Constitution 1a

From Article III of the Constitution 1a

From Title 5, U.S.C., Administrative Procedure Act 1a
§ 701. Application; definitions 1a
§ 702. Right of Review 2a
§ 703. Form and Venue of Proceeding 2a
§ 704. Actions Reviewable 2a
§ 705. Relief Pending Review 3a
§ 706. Scope of Review 3a

From Title 21, U.S.C., Food and Drugs 4a
§ 327. Examinations and Investigations—Authority to Conduct 4a

From the U.S. Code, Title 28 ..... 5a
§ 211. Appointment and Number of Judges .. 5a
§ 1291. Final Decisions of District Courts ... 5a
§ 1338. Patents, plant variety protection, copyrights, trade-marks, and unfair competition 5a
§ 1361. Action to compel an officer of the United States to perform his duty 5a
§ 1391. Venue generally 5a
§ 1393. Divisions; single defendant; defendants in different divisions 6a
§ 2107. Time for appeal to court of appeals .. 6a

From the U.S. Code, Title 35 ..... 6a
§ 1. Establishment 6a
§ 6. Duties of Commissioner 6a
§ 7. Board of Appeals 7a
§ 112. Specification 7a
§ 131. Examination of application 8a
§ 132. Notice of rejection; reexamination ... 8a
§ 141. Appeal to Court of Customs and Patent Appeals 8a
§ 145. Civil action to obtain patent 9a

Page

Opinion of the Court of Appeals Dated December 3, 1974 ..... 10a

Order of the Court of Appeals Denying Rehearing Dated January 30, 1975 ..... 12a

Memorandum Opinion and Order of the District Court Dated November 1, 1973 ..... 13a

From the Patent Office Action of April 1, 1971 .... 16a

From the Patent Office Action of November 7, 1972 17a

From the Commissioner's Decision on Petition, Dated March 21, 1973 ..... 19a

Correction of Commissioner's Opinion, Under Date of August 8, 1973 ..... 20a

From the Patent Office Letter for the File, Dated August 21, 1973, with Exhibit A (Letter of July 13, 1973 to F.D.A.) and Exhibit B (F.D.A.s Reply of August 9, 1973) 21a

Exhibit A, Dated July 13, 1973 ..... 21a

Exhibit B, Dated August 9, 1973 ..... 23a

Rhone-Poulenc's Letter to the Court of Appeals (with Attached Proposed Stipulation) Following the Oral Argument Therein 25a

Stipulation Between the Parties, and Order of the Court Based Thereon, in Settlement of This Appeal 27a

The Commissioner's Letter of Reply, Dated October 15, 1974 ..... 29a

Rhone-Poulenc's Response, Dated October 16, 1974 . 31a

The Commissioner's Petition for Rehearing in the Court of Appeals, with Attached Appendix I .. 34a

Rhone-Poulend's Petition for Rehearing in the Court of Appeals 38a

Examiner's Amendment, Dated March 13, 1975 ..... 42a

Page

ORDER OF THE DISTRICT COURT, DATED MARCH 19, 1975 . 44a

EXCERPT FROM THE INTRODUCTION OF A HARDCOVER BOOK ENTITLED "RUBIDOMYCIN", IN EVIDENCE AS EXHIBIT 3 ..... 46a

CITATIONS

CASES:

Abercrombie & Fitch Co. v. *Baldwin*, 245 U.S. 198 (1917) 16
Barrett v. *Hall*, Fed. Cas. No. 1047 (CC Mass., 1818) . 18
Cohens v. *Virginia*, 6 Wheat. (19 U.S.) 264 (1821) ... 11
Diamond Rubber Co. v. *Consolidated Rubber Tire Co.*, 220 U.S. 428 (1911) 16
Exhibit Supply Co. v. *Ace Patents Corp.*, 315 U.S. 126, 137 (1942) 18
F.C.C. v. *Schreiber*, 381 U.S. 279, 290-1 (1965) 14
In re Gardner, 480 F.2d 879 (1973) 15, 17
Manufacturers' Finance Co. v. *McKey*, 294 U.S. 442, 453 (1935) 11
Muskrat v. *U. S.*, 219 U.S. 346, 355 (1911) 14
Sampson v. *Murray*, 415 U.S. 61, 68-69 (1974) 14
Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U.S. 47 (1938) 16
Swann v. *Charlotte-Mecklenburg Board of Education*, 489 F.2d 966 (4th Cir. 1974) 10
The Telephone Cases, 126 U.S. 1 at 545-6 (1888) 16
Thorpe v. *Housing Authority of Durham*, 393 U.S. 268, 284 (1969) 10
U. S. v. *Anthony Grace & Sons, Inc.*, 384 U.S. 424, 430, 432 (1966) 14
U. S. v. *Ferreira*, 13 How. (54 U.S.) 40 (1851) 14
U. S. v. *Fruehauf*, 365 U.S. 146, 158, reh. den. 365 U.S. 875 (1961) 10
Werk v. *Parker*, 249 U.S. 130, 133 (1919) 5
In re Wood, 155 F.2d 547 (1946) 17
Zenith Corp. v. *Hazeltine Research, Inc.*, 401 U.S. 321, 340 at footnote 8, reh. den. 401 U.S. 1015 (1971).. 11
Zenith Radio Corp. v. *Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969) 11

MISCELLANEOUS: Page

73 C.J.S. 608-9 14
Deller's "Walker on Patents", 2nd Edition, Vol. 5 (1972), p. 127 17
Merk Index, Eighth (1968) Edition, pp. 322, 1484, and 1658 5
Public Law 93-596, 93rd Congress, 88 Stat. 1949 4
"Technology and Culture", Vol. I, No. 2, p. 166 (Spring 1960) 18

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No.

RHONE-POULENC, S.A., DENISE MANCY, LEON NINET & JEAN PREUD'HOMME, *Petitioners,*

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioners respectfully pray that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Fourth Circuit, dated December 3, 1974, in Appeal No. 74-1136 captioned as above.

OPINIONS BELOW

The opinion of the Court of Appeals, reprinted in the Appendix at 10a, is reported at 507 F.2d 261 and 184 USPQ 196 (4th Cir. 1974). The unreported opin-

ion of the United States District Court for the Eastern District of Virginia, Alexandria Division, is reprinted in the Appendix at 13a.

JURISDICTION

The judgment of the United States Court of Appeals for the Fourth Circuit [10a] was entered on December 3, 1974. Timely petitions for rehearing were filed by both the respondent Commissioner of Patents (frequently referred to hereinafter simply as the "Commissioner") and by the petitioners Rhone-Poulenc S. A. et al (frequently referred to hereinafter simply as "Rhone-Poulenc"). Both petitions for rehearing were denied by the Court of Appeals on January 30, 1975 [12a]. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

(1) Whether in this mandamus proceeding brought under the Administrative Procedure Act for the purpose of correcting an action taken by an administrative agency (the United States Patent Office) alleged by petitioners to amount to an abuse of discretion, the United States Court of Appeals for the Fourth Circuit, after having arrived at its decision on the only issue formally ruled upon by the agency's Patent Examiner, the Commissioner of Patents and the District Court, then improperly departed from the legally permissible scope of its appellate review function by creating—for the first time during the oral hearing on appeal—a wholly new issue not theretofore raised on the record, and thereafter deciding that new issue without having had formal (and therefore appeal-

able) rulings successively by the Examiner, the Commissioner and the District Court on that new issue.

(2) Whether the Court of Appeals impermissibly encroached upon the function of the District Court by proceeding as in Question (1).

(3) Whether, as an Article III court, the Court of Appeals impermissibly encroached upon the function of the administrative agency by proceeding as in Question (1).

(4) Whether the Court of Appeals in this mandamus action brought under the Administrative Procedure Act erred in not confining its decision to the single issue ruled on by the Patent Examiner, the Commissioner and the District Court.

(5) Whether it was a denial of due process for a Court of Appeals to force a patent applicant against his will to employ qualifying and unduly restrictive language of description in the specification of his patent application claiming an admittedly patentable invention where, because of the timing and the manner in which the issue was raised in that court at oral argument, there was no possibility of appeal.

(6) Whether the ruling of the Court of Appeals here and a recent ruling of the Court of Customs and Patent Appeals present such a hopeless conflict as can only be resolved by this Court on certiorari.

STATUTORY PROVISIONS INVOLVED

The constitutional and statutory provisions principally involved are those which relate explicitly or implicitly to the proper role of a United States Court of Appeals in the Federal Judiciary System, both with

respect to the lower Federal courts and with respect to an administrative agency, in this case the United States Patent Office.[1]

The constitutional provisions are Article I, Section 8, Clause 8, and Article III.

The principal statutory provisions are those of the Administrative Procedure Act, 5 U.S.C. §§ 701-706; of 28 U.S.C. § 1291, setting forth the jurisdiction of courts of appeals from final decisions of district courts; and of 35 U.S.C. §§ 1, 6, 7, 112, 131, 141 and 145, showing the organization and function of the United States Patent Office with particular regard to the *ex parte* prosecution of patent applications and the relationship of the functions of the Patent Office to those of the courts charged with the review of Patent Office decisions.

The pertinent constitutional and statutory provisions, as well as certain statutory provisions that are at least of perhipheral interest, are all set out in the attached Appendix.

STATEMENT OF THE CASE

On November 14, 1968 the three individual petitioners, as assignors to the corporate petitioner,[2] filed their

---

[1] By an Act approved January 2, 1975 (Public Law 93-596, 93rd Congress, 88 Stat. 1949), the name of the United States Patent Office was changed to the United States Patent and Trademark Office, and the title of the Commissioner of Patents was revised accordingly. However, for convenience the former names will be employed throughout this petition.

[2] For brevity, the petitioners will generally be referred to collectively simply as "Rhone-Poulenc". Rhone-Poulenc is one of the largest chemical concerns in Europe. The individual petitioners are distinguished scientists in their own right. See 46a to 48a.

U.S. application involved herein, which is Serial No. 775,904 entitled, "New Process for the Preparation of Daunorubicin". Daunorubicin [3] is an antibiotic which can be prepared by various methods, one of which is described and claimed in the application just mentioned, namely, by aerobically cultivating certain microorganisms called *Streptomyces griseus, var. rubidofaciens, DS 32,041 (NRRL 3383)* in a certain manner defined in the claims. All the claims of the application are directed to a novel process for the production of the antibiotic, and ultimately the Patent Office determined that this was patentable process and allowed all the claims [18a].

The controversy revolves about a certain wording at page 9, line 15 of the specification of the aforesaid application. The entire paragraph including the questioned wording reads as follows:

> "*S. griseus, var. rubidofaciens, strain DS 32,041* differs from the species distinguished by S. A. Waksman within the series of the strains of *S. griseus,* of which none of those hitherto described gives a soluble red pigment comparable to that produced by the strain DS 32,041 nor gives any production of antibiotic and anti-tumour substance identical to daunorubicin (The Actinomycetes, Vol. II, S. A. Waksman, The Williams and Wilkins Company, Baltimore, 1961, pages 140-143)."

The Patent Office required the cancellation of reference to "and anti-tumour", apparently on the mistaken assumption that Rhone-Poulenc was attempting to assert that the antibiotic daunorubicin (which it is the

---

[3] Also known as *daunomycin* or *rubidomycin.* See the well known Merck Index, Eighth (1968) Edition, pp. 322, 1484 and 1658. *Werk* v. *Parker,* 249 U.S. 130, 133 (1919).

object of the allowed claims to produce) was effective against *all* tumours.

After taking an appeal to the Patent Office Board of Appeals and filing an appeal brief, the Examiner on November 7, 1972 allowed all the claims, but objected to the specification at the place indicated saying that:

> "Cancellation of said term or proof that the instant compound is safe, reliable and effective for the utility set forth is in order". [18a].

In reply, Rhone-Poulenc showed by reference to the contents of an earlier Rhone-Poulenc application then pending in the Patent Office on the antibiotic itself that there was *already* in existence in the Patent Office considerable proof of utility of daunorubicin as an anti-tumour substance, including work done on a clinical basis and not merely on experimental animals.

Later, on February 16, 1973 the Examiner again required cancellation of this term ("and anti-tumour"), which was said to encompass the treatment "of all types of cancers", or proof of the allegation. Seeking relief from the Examiner's requirement, Rhone-Poulenc petitioned the Commissioner who, on March 21, 1973, ruled that there was no abuse of discretion in the Examiner's requirement to cancel [19a].

Thereafter, on April 19, 1973, Rhone-Poulenc filed its complaint in the District Court under the Administrative Procedure Act (5 U.S.C. §§ 701-706) as well as under 28 U.S.C. § 1361.

In connection with the proceedings in the District Court, the Patent Office on August 21, 1973 made of record a request for review by the Food and Drug Administration (under 21 U.S.C. § 372) of certain

aspects of the controversy, including its letter of July 13, 1973 and the F.D.A.'s reply of August 9, 1973 [see 21a to 24a].

On August 9, 1973 the Food and Drug Administration reported back to the Patent Office saying, among other things, that:

> ". . . a review of the available information indicates that daunorubicin has shown a few good responses in lymphosarcoma,[4] nephroblastoma,[4] and neuroblastoma.[4] Also the drug may be regarded as effective in initiating remissions in acute lymphoblastic leukemia [4] and acute myeloblastic leukemia." [4] [23a-24a]

On November 1, 1973, the District Court ruled against Rhone-Poulenc [13a], although stating in part that:

> "[i]t would seem more reasonable, in the context in which the phrase appears, to conclude that the phrase meant no more than the substance had different properties which deter some tumours than the substance and species from which the invention was sought to be distinguished, described in the first part of the paragraph [on page 9 of the specification]." [15a]

The District Court ruled that the Patent Office action could not be considered "arbitrary and capricious even though this [District] Court might not agree with that conclusion". [15a]

A timely appeal was taken to the United States Court of Appeals for the Fourth Circuit (No. 74-1136). The appeal was of course briefed on the matters presented by the record in the Patent Office and in the District Court.

---

[4] Kinds of tumor.

At the oral argument (on October 2, 1974) the Court of Appeals *for the first time* plunged into a consideration of the case on an entirely different basis from that presented by the record. As perhaps best showing in detail precisely what happened, as well as the aftermath, reference is made to the letters directed to the Court of Appeals on October 11, 1974 by petitioners, on October 15, 1974 by the Commissioners, and on October 16, 1974 in reply by the petitioners. These (together with the attachments referred to therein) are all reprinted in the Appendix hereinafter at 25a to 34a.

Thereafter, on December 3, 1974, the Court of Appeals handed down its decision which in the last paragraph concluded by ruling (in *petitioners'* favor) that the requirement by the Patent Office that the words "and anti-tumour" be cancelled was "arbitrary and capricious", and the decision of the District Court was *reversed* [12a].

However, the Court continued by *then* proceeding to rule that

> "[t]he cancellation requirement is set aside with leave to the Commissioner to allow an amendment *restricting*[5] the specification to assertions that are supported by the applicants' proof". [12a]

Timely petitions for rehearing were filed by both the Commissioner[6] and the petitioners. Both petitions for

---

[5] Emphasis added in all quotations from opinions unless otherwise indicated.

[6] At the specific request of the Solicitor of the U. S. Patent Office, the Commissioner's Request for Rehearing is reprinted in the Appendix [34a]. It therefore seems not inappropriate to also reprint petitioners' Request for Rehearing [38a].

rehearing were *denied* by an order of the Court of Appeals under date of January 30, 1975 [12a].

Thereafter, and pursuant to the ruling of the Court of Appeals, the Patent Office proceeded to enter an Examiner's Amendment in the petitioners' patent application under date of March 13, 1975, by which the Patent Office initiated an amendment of the questioned paragraph in a manner conforming to the requirements laid down by the Court of Appeals [42a to 44a].

Finally, the District Court entered an Order on March 19, 1975 pursuant to the mandate of the Court of Appeals, approving what the Patent Office had already done by Examiner's Amendment, subject only to the right of petitioners to file a timely petition for a writ of certiorari to this Court [44a].

REASONS FOR GRANTING THE WRIT

(1) The Court of Appeals, Having Decided the Only Question Presented by the Record for Its Decision, Should at that Point Have "Stopped" and Not Thereafter Have Proceeded To Decide a Question Not Presented by the Record.

Having correctly concluded that the requirement by the Patent Office to cancel the words "and anti-tumour" was arbitrary and capricious and thereupon reversing the decision of the District Court, it is respectfully submitted that the Court of Appeals should have *stopped* at that point. This is for the reason that the only question presented by the record of the proceedings in the Patent Office and in the District Court was whether or not the requirement to cancel those words was arbitrary and capricious. Consequently, having made its decision on the only point properly presented to it on the record, the Court of Appeals had at that instant "exhausted" its appellate review func-

tion, and there was nothing further before it upon which an appellate decision could legitimately operate. To proceed further, as it did, was to render an advisory opinion. This has uniformly been condemned by this Court—and indeed on at least one recent occasion by the very court below. See *U. S.* v. *Fruehauf,* 365 U.S. 146, 158, reh.den. 365 U.S. 875 (1961) and *Thorpe* v *Housing Authority of Durham,* 393 U.S. 268, 284 (1969)

In *Swann* v. *Charlotte-Mecklenburg Board of Education,* 489 F.2d 966 (4th Cir. 1974), the court below, in an *en banc* opinion, stated that:

> "[t]his court does not sit to render decisions on abstract legal propositions or advisory opinions".

Why it departed from that salutary principle only a few months later in the present case is very much of a mystery.

(2) The Court of Appeals Should Not in Any Event Have Decided or Have Purported To Decide an Issue on Appeal that Was Not Presented to and Decided by the Lower Court.

It is petitioners' respectful submission that under the only relevant statute conferring appellate jurisdiction upon it (28 U.S.C. § 1291), the Court of Appeals had no authority to decide an issue or a question that was not presented to *and decided by* the District Court. It is self-evident that if a District Court has not passed upon or decided a particular question, there is nothing before an appellate court upon which the latter may properly exercise or bring to bear its only appropriate function, namely, that of appellate review. This Court should make it clear that courts of appeals are not

courts of *nisi prius,* and that however tempting the provocation, they should not act like one.

In *Cohens* v. *Virginia,* 6 Wheat. (19 U.S.) 264 (1821), this Court stated that

> "[i]t is most true that this court will not take jurisdiction if it should not; but it is equally true, that it must take jurisdiction if it should . . . We have no more right to decline the exercise of jurisdiction which is given, than to usurp that which is not given. The one or the other would be treason to the Constitution" (p. 404).

Although obviously such strong language would be hyperbole if applied to the result in this particular case, it is nevertheless true that the court below, like any other court, should have refrained from taking jurisdiction (i.e., deciding) in a situation such as here where, in the petitioners' respectful submission, it went so far afield from what was presented to it for decision by the record. To similar effect, see *Manufacturers' Finance Co.* v. *McKey.* 294 U.S. 442, 453 (1935); *Zenith Radio Corp.* v. *Hazeltine Research, Inc.,* 395 U.S. 100, 123 (1969); and *Zenith Corp.* v. *Hazeltine Research, Inc.,* 401 U.S. 321, 340 at footnote 8, reh.den. 401 U.S. 1015 (1971).

(3) The Court of Appeals, as an Article III Court, Should Have Refrained From Encroaching Upon the Jurisdiction of the Administrative Agency Specifically empowered by Congress To Decide in the First Instance Questions Arising During the Ex Parte Prosecution of Patent applications, Including Questions of Alleged New Matter.

The Court of Appeals, as an Article III court, had no business, in petitioners' respectful submission, in encroaching upon the function of the very administrative agency to which Congress has confided the

power to decide in the first instance questions relating to the *ex parte* prosecution of a patent application, including for example questions of alleged new matter.

Under Article I, Section 8, Clause 8, the Constitution confers practically unlimited authority upon the Congress to provide for a patent system for the United States.

The patent statute (35 U.S.C. § 1) establishes and continues the Patent Office as an office in the Department of Commerce. Under § 6, the Commissioner (under the direction of the Secretary of Commerce) is given the power to superintend or perform all duties required by law respecting the granting and issuing of patents. To assist him in those duties conferred upon him by statute, besides Examiners and other lower level personnel, § 7 creates a Board of Appeals consisting of Examiners-in-Chief who review adverse decisions of Examiners upon applications for patents. The Examiner's review of applications for patents includes of course a consideration of the contents of the patent specification (§ 112). The Commissioner (using his staff of Examiners) causes an examination to be made of the application (§ 131) and notifies the applicant of the reasons for any applicable rejections, objections, or requirements (§ 132). The last sentence of § 132 specifically provides that "[n]o amendment shall introduce new matter into the disclosure of the invention".

It is thus clear that the *examination* of patent applications, including the consideration of whether or not new matter has been introduced into a patent specification by amendment, has been entrusted *in the first instance* to the Patent Office and not to any court.

Of course, if the Examiner makes a rejection which in the opinion of the applicant is erroneous, the applicant may seek remedy from the Board of Appeals whose duty it is to review adverse decisions of Examiners upon applications for patents (§ 7). If the Board of Appeals should render a decision which in the applicant's opinion is erroneous, the applicant has a further remedy by pursuing an appeal on the record to the Court of Customs and Patent Appeals (§ 141) or by bringing a civil action against the Commissioner in the United States District Court for the District of Columbia (§ 145).

It is to be particularly noted that each of those sections providing for review of administrative agency action by a court is introduced by precisely the same language:

> "An applicant dissatisfied with the decision of the Board of Appeals may . . . etc."

It is thus clear, if the matter were otherwise in doubt, that it was the intent of Congress to confer upon the courts a strictly appellate review function in connection with *ex parte* matters of the kind here involved.

Since the Court of Appeals is an Article III court, it is respectfully submitted that by, in effect, taking over the administrative function of the Patent Office by "allowing" the entry of a restrictive amendment for the first time at the appellate level, the court below inadmissibly crossed over the line separating the judicial department on the one hand from the legislative and executive departments on the other, and thus violated the traditional doctrine of separation of powers as between the three great departments of the Government.

Although obviously well-intentioned procedurally, the net effect of the action of the Court of Appeals was entirely unsound substantively.

In *U. S.* v. *Ferreira,* 13 How. (54 U.S.) 40 (1851), there appears at the end of the report a "note by the Chief Justice, inserted by order of the Court" referring to a still earlier case. The purport of the note is that this Court is keenly aware of the lines drawn between the three great branches of the Government. The note shows that in one of the very earliest cases to arise in this Court (in 1794), the decision was that an act of Congress could not confer upon the circuit courts of the United States a power which was not a judicial power and that the attempt to do so was unconstitutional. See also *Muskrat* v. *U. S.,* 219 U.S. 346, 355 (1911); *F.C.C.* v. *Schreiber,* 381 U.S. 279, 290-1 (1965); *U.S.* v. *Anthony Grace & Sons, Inc.,* 384 U.S. 424, 430, 432 (1966); and *Sampson* v. *Murray,* 415 U.S. 61, 68-69 (1974).

That this indeed appears to be the general rule is shown by the following quotation from 73 C.J.S. at pp. 608-9:

> "However, the court may not direct the administrative body as to what order or decision it should make, since the court oversteps the boundaries of its jurisdiction when it attempts to tell the body what its action should be, ..."

(4) The Decision of the Court of Appeals Purporting To Give Leave to the Commissioner To "Allow" a Restrictive Amendment to Petitioners' Specification Describing an Admittedly Patentable Invention Presents a Direct Conflict With a Recent Decision of the Court of Customs and Patent Appeals—a Conflict That Can Only Be Resolved by This Court on Certiorari.

It is evident from the decision of the court below that the Court of Appeals thought it quite permissible to dictate to a patent applicant how he should define his invention in the patent specification via restrictive language. See the Appendix at 12a.

A recent ruling by the Court of Customs and Patent Appeals seems equally clearly to indicate that *that* court is of exactly the *opposite* opinion. Thus, in *In re Gardner*, 480 F.2d 879 (1973), we find the following holding by the Court of Customs and Patent Appeals:

> "Whether the descriptive part of the specification should be amended to include the language of claim 2 is more of an administrative matter to be settled in the Patent Office *and is not a proper basis for our decision on the merits of this rejection.*"

Accordingly, there appears to be a direct conflict on an extremely important point of patent law as between the United States Court of Appeals for the Fourth Circuit on the one hand, and the United States Court of Customs and Patent Appeals on the other. Since both of these courts are Article III courts (the CCPA since 1958),[7] there is thus a direct conflict between appellate courts of equal rank and dignity that, in petitioners' respectful submission, can only be settled by this Court.

---

[7] See 28 U.S.C. § 211. Appendix at 5a.

This conflict should be settled for the guidance of all the courts as well as those vitally interested in the patent system including the officials of the Patent Office.

(5) On the Merits, the Court of Appeals Decided the Question of Alleged New Matter in an Erroneous Manner Highly Prejudicial to the Petitioners.

Although the Court of Appeals viewed the words of limitation or restriction which it, in effect, forced upon the petitioners as not involving "new matter" within the meaning of § 132, it is by no means clear that such is the case. It is petitioners' position that they ought not to be forced against their will to accept an amendment that might possibly render their patent, when issued, subject to attack on that ground.

The Court of Appeals failed to take sufficiently into account the distinction between, on the one hand, properties that are inherently present in an invention otherwise fully disclosed and which therefore an inventor is entitled to *cover* by means of broad and non-exclusionary language even though not specifically mentioned in his specification, and on the other hand, properties which not only were neither inherent nor expressly disclosed in a specification but also which could not have been so disclosed without a charge of new matter that might possibly invalidate the patent. These extremes are quite well illustrated by *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428 (1911), especially at pp. 434-7, and *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47 (1938), especially at pp. 57-9. For the first alternative, see also *Abercrombie & Fitch Co.* v. *Baldwin*, 245 U.S. 198 (1917). See also *The Telephone Cases*, 126 U.S. 1 at 545-6 (1888).

The most important consideration, however, is that this Court should grant certiorari for the purpose of clarifying the right of an inventor or patent applicant to select the language that he wishes to use for describing his invention without being *forced* to use such language as some court might happen to think better suited to the purpose. That principle has already been recognized by a number of authorities. Thus in, *In re Wood,* 155 F.2d 547 (1946), the CCPA pointed out that

> "[s]urely as a general proposition the one who prepares the application and familiarizes himself with his case and the prior art and the applicable law ought to have considerable latitude in determining what is necessary for the full protection of his patent rights."

Although this statement was made in connection with the question of how many *claims* were necessary to protect an admitted invention, it would appear that the same general principle should apply to the question of language in the *specification* considered by an applicant to be necessary or desirable for describing matters relevant to his admitted invention.

Note that *Wood* was decided many years before the CCPA was "converted" into an Article III court by the Congress in 1958. Since acquiring that status the CCPA has made an even more, pointed and relevant observation in the case of *In re Gardner, supra.*

One of the most authoritative treatises on patent law is to the same effect. See Deller's "Walker on Patents," 2nd Edition, Vol. 5 (1972), p. 127, where in speaking of "The Specification", it is stated that

> "[a]n inventor has the right to use such words as seem to him to best describe his invention".

In response to the frequently-expressed fear by petitioners that in being forced to adopt unduly restrictive language for their specification some kind of file wrapper estoppel might arise, both the Commissioner and the District Court indicated, in effect, that this could hardly happen because the record would make it clear that petitioners were forced to do so by action imposed upon them from without.[8] Petitioners' fears in this regard are by no means allayed by that argument, however, for the reason that this Court, in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126,137 (1942), ruled that file wrapper estoppel against an applicant could arise from his amendment of a claim in response to a criticism or objection made by the Examiner *quite apart from whether the Examiner was right or wrong in rejecting the claim.* By a parity of reasoning, it would appear that the same result might equally follow where the change in question was forced upon an applicant by an authority much higher than the Examiner; viz., a court of appeals.

While on circuit duty near the beginning of the last century, Justice Story pointed out that "[t]he doctrine of patents may truly be said to constitute the metaphysics of the law", *Barrett* v. *Hall,* Fed. Cas. No. 1047 (CC Mass., 1818). The same thought was expressed not very long ago by Dr. Nathan Reingold, Science Bibliographer in the Science and Technology Division of the Library of Congress. See "Technology and Culture", Vol. I, No. 2, p. 166 (Spring 1960). If one accepts this viewpoint, then there would appear to be even less reason for viewing with composure the action of an appellate court in dealing with a difficult issue in a

---

[8] A force majeure? See the Appendix at 15a-16a.

branch of law that is said to have metaphysical overtones without first having had the benefit of the expertise of those in the very administrative agency to which Congress has entrusted the authority to take the initial action in such matters.

Since the action complained of herein was taken *sua sponte* by the court below at the second highest level of the Federal judiciary, and therefore without any right of appeal, petitioners have no place to turn to for relief save to this Court.

CONCLUSION

Petitioners respectfully urge this Court to hear this case on the merits by issuing a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit; and more particularly, to vacate or reverse the lower court's direction to the Commissioner to "allow" the unduly restrictive amendment to the specification of petitioner's otherwise allowable patent application, but to affirm that portion of the lower court's decision by which the Examiner's requirement to cancel was ruled to be "arbitrary and capricious".

Respectfully submitted,

ELLSWORTH H. MOSHER
CHARLES A. WENDEL
STEVENS, DAVIS, MILLER & MOSHER
1911 Jefferson Davis Highway
Arlington, Virginia 22202
(703) 920-8900

Attorneys for Petitioners

April, 1975